

## Remarks

The office action dated 03/03/2006 has been considered.

The Applicant has filed herein a request for Continued Examination so that new claims and arguments may be considered by the Examiner.

The Applicant acknowledges the Examiners assistance in the telephone interview conducted on February 24, 2006.

The Applicant has now revised the Abstract as requested by the Examiner. The Examiner's objection to claim 1 is now moot in light of the applications cancellation of the claim.

Claim 17 has been amended, and is believed to no longer have any grammatical errors that were not specified by the Examiner in the objection.

The rejection to claim 11 under 35 USC §112 is now moot in light of the Applicants cancellation thereof.

The Examiner rejected claims 1, 3, 4, 7-11 under 35 USC 103(a) as being unpatentable over Leibskind US 2,979,246 in view of Jones US 2,811,298.

The Examiner has rejected claim 2 as being unpatentable over Morris US 5,383,422 in view of Keyes et al. US 3,946,944.

The Examiner has rejected Claim 15 and 16 under 35 USC 103(a) as being unpatentable over Willinger.

The Examiner has rejected Claims 17 under 35 USC 103(a) as being unpatentable under Willinger in view of Leibskind.

It is noted that Claim 12-14 have been previously canceled in view of the Examiner's previous restriction requirement.

Claim 5 is believed to be now in condition for allowance, as it has been amended to incorporate the limitations of the original parent claim 1.

As to Claims 6, it depend directly from independent claim 6, it should also be in condition for allowance.

Claim 7, 8 and 9 have been amended to depend from claim 5, and hence should also be in condition for allowance.

However, the Applicant does not concede that, absent the amendment to claim 10, this claims is not patentable. The Applicant does not agree that the Examiner has established a Prima facie case of obviousness in the first or second office action on the merits with respect to these claims.

Claim 10 is now to more clearly distinguish from the prior art in that the panels form a box that will have a portal on one side, this portal being smaller than the side of the box and offset laterally from the adjacent sides. The kit also includes the substantially rigid foam panels to be inserted into the box, with the vertically positioned panels supporting the upper panel, and a vertical panel having a hole that aligned with the portal in the side of the box.

The Examiner previously rejected claim 10 over Liebskind. Claim 10 differs from the teaching of Liebskind in several unobvious ways. Further, modifying the Leibskind reference as suggested by the Examiner would render Leibskinds invention inoperative for its intended purpose, protecting the contents of articles during shipment.

Claim 10 is for a kit to form an animal shelter. Liebskind's disclosure is of a foam coated plastic carton in which each panel that forms the interior of the finished carton has a foam panel formed during the fabrication of the box. In Lebskind's construction there is no suggestion or need that the panels be made of substantially rigid foam panels so as to support a panel that forms the roof of the box and could support the weight of a small animal sitting on the roof of the shelter. Further, Liebskind contains no suggestion or motivation to provide a hole in the center. The foam attached to the interior wall of Liebskind's box is to cushion an object in the box during shipping. Claim 10 is amended in b) in which the *"substantially rigid foam boards has a hole formed therein to align with the portal in the side of the box"*

The Applicant appreciates the Examiner's concern that the art of shipping containers teaches various shapes and configuration of foam packaging that is semi-rigid and would not completely cover every wall of the box. However, such a packing container if it had an exterior portal, providing an opening in the foam panel at the same

location, meeting the new limitation in amended claim 10, would render this imaginary prior art package unfit for its purpose of protecting goods, as the package would have an unprotected opening where the holes in the wall and insulation/padding align.

Hence, it is the Applicant's position that the Examiner's belief that such art can be found is not only factually in error, but not supported by case law which clearly rejects as prior art an reference that would be rendered inoperable by the modification.

Further, Claim 15, directed to the constructed shelter itself, is amended to overcome the Examiner's rejection, based on prior art that has not been found in the search. With the amended it is more clearly recited the that the box that forms the animal shelter and rigid foam panels expose the same interior cross-section of the box. The new limitation being *"that the substantially rigid foam panel is open to dispose the same portion of the interior cross-section of said box as the opening in the box, thus forming an entrance and exit portal for the insulated animal shelter."*

Further the Applicant believes that a prima facie case of obviousness cannot be established with respect to claim 15, 16 and 17 based on the Willinger reference.

The Willinger reference is a container for shipping fish. The shipping container is insulated and includes a layer of a thermal storage medium for preventing even moderate temperature fluctuations from killing or injuring tropical fish. The fish and water habitat is contained in a plastic bag in contact with a layer of the thermal storage medium 18, which is also in pouch or re4cetacle 16 (column 3, line 6-8). The only opening is in the top where the mouth of a plastic bag 20 is sealed to plastic bag after filling with water, fish and oxygen (column 3, line 20). The space above the bag is covered by a removable lid or cover 15. The lid is of identical insulation materials as the walls (column 2, line 51). The flaps 12 close to completely cover the removable lid or cover 15. Neither the removable lid nor the flaps have a portal or opening that exposes a portion of the cross-section of the interior space. Modifying the lid 15 and/or flaps 12 to have such portal would expose the plastic bag to physical damage, thermal fluctuations that would injure the fish, or allow the leakage or extrusion of the pliable plastic bag containing the fish in water. As such modifications render the Willinger reference inoperable for it's intended purpose, of shipping fish, the reference cannot be consider viable prior art for an

obviousness rejection.

Claims 16 and 17 depended either directly or indirectly from claim 15, and hence should also be in condition for allowance.

New claims 18 and 19 are directed to a method of sheltering a small animal in a shelter having the structural limitations of the disclosure and the independent claims. The new method claims 18-19 contain the same article limitations for the shelter itself, being re-written in a method format to distinguish from the prior art packaging materials which contain no suggestion to use as animals shelters, of which the modification of which to meet the limitations of the Applicant's claim would render them unfit for use as packaging for protection of articles during shipping.

Claims 20 and 21 are new article claims that include the limitation that the insulated box includes a cushion having a flexible outer covering disposed on the lower substantially rigid surface. It is believed that this limitation structurally distinguishes over any prior art that may be found for packaging materials.

Accordingly, it is respectfully submitted that the new claims 18-21 clearly and patentably distinguish over the prior art, since it is believed that the construction defined in these claims differs essentially and in an unobvious, highly advantageous manner from the constructions disclosed in the references. Applicant believes that combining the references discussed above would not lead to the claimed invention, in that the present invention does not merely employ the known substitution of equivalents but rather employs a new, non-obvious combination to accomplish the objectives set out in the present application.

As for the proposed combination of references cited by the Examiner, it is respectfully submitted that since none of the references in the combination teaches the distinctive features of applicant's invention as defined now in the new claims 18-21, any hypothetical construction produced by this combination would not lead to applicant's invention.

It is respectfully submitted that the combined teachings of the references applied by the Examiner fail to disclose or even suggest the subject matter of the claims at issue.

That a prior art reference could be modified to form the claimed structure does not supply a suggestion to do so. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989).

In view of these considerations, it is respectfully submitted that the rejection of the original claims should be considered as no longer tenable with respect to the amended claims and new claims 18-21 and should be withdrawn. The new claims 18-21 should be considered as patentably distinguishing over the art and should be allowed.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully asked that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. Alternatively should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned.

Respectfully submitted:

by: 

on 4/24/2006

Edward S. Sherman, Ph.D.,  
Patent Attorney (Reg. No. 43,115)  
3354 Round Barn Boulevard  
Suite 303  
Santa Rosa, CA 95403  
707)579-0580  
707)528- 6015 (fax)